

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JMM

December 31, 2020

Opposition No. 91252817

House of Kuipers, LLC and Zox, LLC

v.

John Zox

By the Trademark Trial and Appeal Board:

This case comes before the Board for consideration of Opposer House of Kuipers, LLC's construed motion to substitute Zox, LLC as party Opposer. The motion is fully briefed.

I. Background

Applicant, John Zox, seeks registration of the standard character mark ZOX for the following goods¹:

- Non-magnetically encoded gift cards; Stickers and transfers (Int'l Class 16);
- Non-metal identification bracelets (Int'l Class 20);
- All-purpose straps comprised of synthetic textile materials; Sacks or bags for the transportation or storage of materials in bulk; String (Int'l Class 22);
- Fabrics for textile use (Int'l Class 24);

¹ Application Serial No. 88228839, filed December 13, 2018.

- Arm bands; Belt buckles; Charms for shoes; Clothing accessories, namely, charms for attachment to zipper pulls and buttons; Hair bands; Shoe laces (Int'l Class 26); and
- Party games (Int'l Class 28).

On December 10, 2019, Opposer, House of Kuipers, LLC, filed a notice of opposition on the grounds of priority and likelihood of confusion, dilution by blurring, and fraud on the USPTO. Opposer pleads prior common law rights in the mark ZOX for various goods and services, including clothing and accessories, as well as ownership of the following registrations and application:

Reg. or Serial No. (Date)	Mark	Goods/Services
Reg. No. 4412948 (October 8, 2013)	ZOX STRAPS (standard character; “straps” disclaimed)	Elastic fabric wristbands in the nature of a bracelet (Int'l Class 14)
Reg. No. 4465691 (January 14, 2014)	ZOX (standard character)	Wristbands in the nature of a bracelet (Int'l Class 14); Wristbands; shirts (Int'l Class 25)
Reg. No. 4759961 (June 23, 2015)	ZOXBOX (standard character; section 2(f) claim in whole)	Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Wristbands (Int'l Class 25)
Reg. No. 5233845 (June 27, 2017)	ZOX (standard character)	Backpacks (Int'l Class 18); On-line retail and wholesale store services featuring clothing apparel, wristbands, bags and accessories (Int'l Class 35)
App. Serial No. 88659217 (October 17, 2019)	ZOX (standard character)	Coloring books; Prints (Int'l Class 16)

On March 19, 2020, Applicant filed an answer denying the salient allegations in the notice of opposition and asserting thirteen “Affirmative Defenses.” Applicant also filed counterclaims to cancel Opposer’s pleaded Registration Nos. 4465691, 4759961,

and 5233845 on the grounds of priority and likelihood of confusion², partial abandonment³, and fraud⁴. On May 22, 2020, Opposer filed an answer denying the salient allegations in the counterclaims and raising seven “Affirmative Defenses.”

II. Zox, LLC Joined as Opposer

On June 17, 2020, Opposer filed a “Notice of Change of Ownership” as to its pleaded Registration Nos. 4412948, 4465691, 4759961 and 5233845. (18 TTABVUE). Opposer stated that it “assigned all rights, title and business good will” in the registrations to Zox, LLC, and that “Zox, LLC will ‘step into the shoes’ of House of Kuiper’s LLC and will continue prosecution of this action.” (*Id.* at 2). Opposer also provided a copy of the notice of recordation of assignment, which was recorded with the USPTO’s Assignment Recordation Branch at Reel/Frame 6945/0227.⁵ (*Id.* at 5). On September 3, 2020, the Board construed Opposer’s submission as a motion to substitute Zox, LLC as party opposer in this proceeding. (19, 20 TTABVUE).

On September 23, 2020, Applicant filed his response to the construed motion to substitute and contends that, because the assignment occurred after the commencement of this proceeding, Zox, LLC should be joined rather than substituted as a plaintiff.⁶ (21 TTABVUE). On October 1, 2020, Opposer filed a reply, stating that

² The priority and likelihood of confusion counterclaim applies only to Registration Nos. 4759961 and 5233845.

³ The abandonment counterclaim applies only to Registration Nos. 4465691 and 4759961.

⁴ The fraud counterclaim applies only to Registration Nos. 4465691 and 5233845.

⁵ Although not referenced in Opposer’s Notice of Change of Ownership, Opposer’s pleaded application Serial No. 88659217 was also included as part of the assignment.

⁶ The certificate of service for Applicant’s response to the construed motion to substitute was filed separately. (22 TTABVUE). In addition, Applicant’s change of correspondence address, also filed September 23, 2020, is noted.

“the relevant factors weigh against substitution and in favor of joinder.” (24 TTABVUE 4).

“When there has been an assignment of a mark that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board’s own initiative.” TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 512.01 (2020) (and cases cited therein). “When the assignment is recorded in the Assignment Recordation Branch of the USPTO, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding, the assignor is no longer in existence, the plaintiff raises no objections to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery.” *Id.*

In view of the foregoing, the construed motion to substitute is DENIED. Zox, LLC is hereby JOINED as a party Opposer in Opposition No. 91252817.⁷

III. Review of the Pleaded Claims and Counterclaims

On November 23, 2020, Opposer, House of Kuipers, LLC, filed a motion for leave to amend its notice of opposition. (25 TTABVUE). Opposer’s motion is DENIED without prejudice for being improperly filed while proceedings were suspended pending disposition of the construed motion to substitute. Nonetheless, to avoid

⁷ The Board notes that both Opposers, House of Kuipers, LLC and Zox, LLC, are represented by Cislo & Thomas, LLP. If, at any point in the future of this proceeding, Opposers are not represented by the same counsel, Opposers will be required to designate one lead counsel to whom the Board may send postal correspondence intended for Opposers.

further delay in this proceeding, the Board has sua sponte reviewed the pleaded claims and counterclaims and makes the following findings.

A. Notice of Opposition

On the Electronic System for Trademark Trials and Appeals (ESTTA) generated filing form, Opposers identified the grounds for opposition as priority and likelihood of confusion, dilution by blurring, and fraud on the USPTO. However, Opposers did not did not separate the individual claims using headings or sections in the body of the attached, enumerated complaint. While Opposers were not required to provide separate headings, it is difficult to determine whether a given numbered allegation is an independent claim for opposition or a factual allegation intended to support some other claim. Accordingly, the Board will not parse the notice of opposition to identify any additional potential claims that Opposers may have attempted to allege.⁸

Upon review of the notice of opposition, the Board finds that Opposers have sufficiently pleaded their entitlement to bring a statutory cause of action⁹ and claims of (i) priority and likelihood of confusion and (ii) dilution by blurring. However, Opposers have not pleaded a legally sufficient claim of fraud.

⁸ For example, in the notice of opposition, Opposers allege that the involved application should be refused because Applicant's mark "is primarily merely a surname," "does not function as a trademark," and "has been abandoned." (1 TTABVUE 7–8, ¶¶ 3–4, 6). However, in the motion for leave to amend, addressed above, Opposers contend that the pleaded grounds for opposition are priority and likelihood of confusion, dilution by blurring, and fraud. (25 TTABVUE 2–3).

⁹ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063–64, under the rubric of "standing." Mindful of the Supreme Court's direction in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125–26 (2014), we now refer to this inquiry as entitlement to bring a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

A legally sufficient pleading of fraud in procuring a registration requires allegations that (1) applicant made a false representation to the USPTO; (2) the false representation is material to the registrability of the mark; (3) applicant had knowledge of the falsity of the representation; and (4) applicant made the representation with intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). A plaintiff must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b). *Asian & W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478–79 (TTAB 2009). Knowledge and intent, as conditions of mind of a person, may be alleged generally. *See* Fed. R. Civ. P. 9(b); *Daimler Chrysler Corp. v. Am. Motors Corp.*, 94 USPQ2d 1086, 1088 (TTAB 2010). However, “an allegation that a declarant ‘should have known’ a material statement was false does not make out a proper pleading.” *Asian & W. Classics B.V.*, 92 USPQ2d at 1479.

While the notice of opposition has been considered in its entirety, relevant to the fraud claim, Opposers allege that:

5. The Applicant’s Application should be refused because registration is being sought fraudulently in violation of 15 U.S.C. § 1064(3). As House of Kuipers’ has grown more famous, so have the claims of Applicant that it also now sells the same goods or goods in close proximity to House of Kuipers Goods in interstate commerce. Since as early as 2014, Applicant has sought to register trademarks that infringe upon and dilute the House of Kuipers’ Trademarks (See Serial No. 86954997) on the basis that because Applicant’s last name is ZOX and Applicant’s late musical band was called “ZOX,” it should be entitled to the ZOX trademark across a wide variety of goods. Applicant’s musical band, ZOX, has not toured since 2014, and Applicant’s specimens do not show goods that have actually been produced, rather provide mockups of goods that Applicant may produce and sell. House of Kuipers has reason to believe that Applicant has not sold any or most of the goods claimed by Applicant in interstate commerce at any point or at least not for five years prior to this Application.

(1 TTABVUE 7–8, ¶ 5). This is insufficient to plead a claim of fraud based on nonuse. In particular, Opposers must plead that Applicant was not using his mark on his identified goods and/or services as of the filing date of the application¹⁰; that Applicant made a false representation to the USPTO regarding his use of his mark; that false representation is material to the registrability of the mark; that Applicant had knowledge of the falsity of the representation; and that Applicant made the representation with intent to deceive the USPTO.¹¹

In view of the foregoing, Opposers' fraud claim is sua sponte STRICKEN. *See* Fed. R. Civ. P. 12(f); *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007); *W. Worldwide Enters. Grp. Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990).

B. Counterclaims For Cancellation

Applicant has entitlement to bring a statutory cause of action with respect to his counterclaims by virtue of being the defendant in the opposition proceeding. *See Anthony's Pizza & Pasta Int'l. Inc. v. Anthony's Pizza Holding Co.*, 95 USPQ2d 1271,

¹⁰ To the extent Opposers contend that Applicant was not using his mark on some of the identified goods and/or services at the time of filing the application, Opposers must identify which goods and/or services they allege were not in use.

¹¹ The Board also notes that it is well-settled that the adequacy of specimens submitted during the prosecution of an application is solely a matter of ex parte examination and, therefore, does not constitute grounds for opposing the registration of a mark. *See Granny's Submarine Sandwiches, Inc. v. Granny's Kitchen, Inc.*, 199 USPQ 564, 567 (TTAB 1978); *see also Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989). When faced with a claim of fraud based on nonuse, the appropriate question before the Board is whether the accused party has established use in commerce as of the filing date of a used based application or the filing date of the Statement of Use in an intent to use based application that matured into registration. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009).

1274 (TTAB 2009) (“Defendant has standing to cancel plaintiff’s pleaded registration by virtue of being the defendant in the consolidated proceeding, and the fact that plaintiff has asserted its registration against defendant.”), *aff’d*, 415 Fed. Appx. 222 (Fed. Cir. 2010). In addition, upon review of the counterclaims for cancellation, the Board finds that Applicant has pleaded the following legally sufficient claims: priority and likelihood of confusion as to Registration Nos. 4759961 and 5233845;¹² partial abandonment as to Registration Nos. 4465691 and 4759961;¹³ and fraud based on nonuse as to Registration Nos. 4465691 and 5233845.¹⁴

However, to the extent Applicant intended to plead a claim of fraud based on Opposers’ prior knowledge, at the time of filing the underlying applications, of Applicant’s confusingly similar mark, Applicant has not properly pleaded this claim. Such a claim of fraud must allege particular facts which, if proven, would establish

¹² Reg. No. 4465691, issued January 14, 2014, was more than five years old as of the institution date of this proceeding. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 508 (Fed. Cir. 1983) (“Under § 14, a petition to cancel a registration of a mark is precluded after five years, except on limited grounds Thus, § 2(d) grounds for cancellation, including likelihood of confusion as to the source of goods or services, is not permitted after five years”).

¹³ Although Applicant identified abandonment as one of his counterclaims for cancellation on the ESTTA filing form, in the attached, enumerated pleading, Applicant identified his claim as both abandonment and non-use. These are separate claims, and the Board will not construe Applicant’s counterclaims to include a claim of nonuse. Moreover, a nonuse claim against Registration No. 4465691 is time-barred. *See Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 USPQ2d 1899, 1906 n.6 (TTAB 2006) (registration more than 5 years old may not be challenged on ground that mark was not used in commerce at time of application filing). An abandonment claim, on the other hand, is not time-barred under Section 14.

¹⁴ Statements regarding the use of the mark on the identified goods and/or services are certainly material to issuance of a registration; however, if the mark was in use in commerce as of the filing date of the underlying application, or the statement of use, then the claimed date of first use, even if false, does not constitute fraud because the first use date is not material to the Office’s decision to approve a mark for publication. *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1926 (TTAB 2006).

that (1) there was in fact another user of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to the applicant's; (3) the applicant knew that the other user had rights in the mark superior to those of the applicant and either believed that a likelihood of confusion would result from the applicant's use of its mark or had no basis for believing otherwise; and that (4) the applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled. *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1206 (TTAB 1997); *see also Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1149 (TTAB 2016). Applicant contends only that "[o]n information and belief, Opposer was aware of Applicant's use in commerce of ZOX in connection at the time it filed the above applications and Sections 8 and 15 affidavits." (12 TTABVUE 26, ¶ 78). This is insufficient to plead a claim of fraud under *Intellimedia*.

IV. Leave to Replead

It is the Board's policy to allow amendment of defective pleadings, particularly where the offending pleading is the initial pleading. *See, e.g., Intellimedia Sports Inc.*, 43 USPQ2d at 1208.

As a result, Opposers are allowed **THIRTY (30) DAYS** from the date of this order to file an amended notice of opposition that sets forth a legally sufficient claim of fraud. In addition, to the extent Opposers intended to plead claims of primarily merely a surname, failure to function, and/or abandonment, Opposers are also allowed leave to include such claims in any amended notice of opposition, provided

Opposers have a good-faith basis for doing so.¹⁵ The Board exercises its discretion to require that any amended notice of opposition include a separate heading for each claim and that each claim be fully and sufficiently alleged under its separate heading. If Opposers do not file an amended notice of opposition within thirty days, this proceeding will move forward only as to Opposers' claims of (i) priority and likelihood of confusion and (ii) dilution by blurring.

In addition, Applicant is allowed **THIRTY (30) DAYS** from the date of service of any amended notice of opposition to file an answer thereto, as well as amended counterclaims to cancel that set forth a legally sufficient claim of fraud based on Opposers' prior knowledge, at the time of filing the relevant underlying applications, of Applicant's confusingly similar mark. Opposers are allowed **TWENTY (20) DAYS** from the date of service of any amended counterclaims to file an answer thereto. If Applicant does not file amended counterclaims, this proceeding will move forward only as to the legally-sufficient counterclaims identified above.

Proceedings remain **SUSPENDED** but for the parties' respective, amended pleadings. Once the pleadings have closed, the Board may consolidate this proceeding with Cancellation No. 92074323.

¹⁵ Opposers are strongly encouraged to review the pleading standards for such claims before filing any amended notice of opposition.